

Remarks

Restriction Requirement

In the Action mailed August 11, 2005, the Office restricted the application to the following Groups of claims:

Group I - Claims 1-3, drawn to a method for determining the *Phytophthora sojae* resistance associated with the trait locus *Rps8* in soybean and a soybean seed produced from said method,

Group II - Claims 4-9, drawn to a method for introgressing soybean *Phytophthora sojae* resistance into non-resistant soybean germplasm and soybean seed produced from said method,

Group III - Claims 10-19, drawn to a method for the production of a soybean cultivar adapted for conferring, in hybrid combination with a susceptible second inbred, resistance to *Phytophthora sojae*, and

Group IV - Claims 20-24, drawn to a soybean plant or seed.

Election and Traverse

In response to the Restriction Requirement, Applicant elects Group I, i.e. claims 1-3, **with traverse.**

The Office carefully makes the case that the claims of Groups I, II, III and IV are distinct:

Because these inventions are *distinct* for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

(Office Action, Page 7, emphasis added.) Here the Office concludes that because distinctiveness has been shown, restriction is proper.

Applicants submit that restriction is not proper in this instance. M.P.E.P. § 803 states the requirement for a *proper* restriction.

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; *and (B) There must be a serious burden on the examiner if restriction is required.*

(M.P.E.P. § 803, citations omitted, emphasis added.) Thus, there are *two* requirements for restriction: distinctness *and* a serious burden. Both are required; distinctness without a serious burden is not sufficient to justify restriction. Indeed, section 803 explicitly states that “[i]f the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.” (Emphasis added.)

Applicant respectfully submits that restriction is not proper in this case. While the claims of Groups I, II, III and IV may satisfy the Office’s requirements for distinctness, their consideration would not result in a serious burden on the Office. The Office argues that an undue burden would result from considering more than one group; Applicants respectfully disagree.

For these reasons, Applicants respectfully request that the Office consider Groups I, II, III and IV together.

Application No. 10/778,018
Attorney Docket No. 22727/04212
Response to Office Action

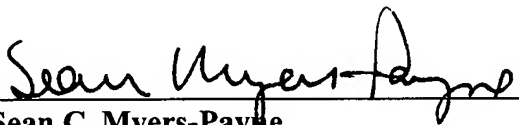
Conclusion

For the foregoing reasons, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness, and respectfully request withdrawal of the rejections.

If there is any fee due in connection with the filing of this Response, please charge the fee to our Deposit Account No. 03-0172.

Respectfully submitted,

Date: December 6, 2005


Sean C. Myers-Payne
Reg. No. 42,920
(614) 621-7754
(614) 621-0010 (fax)
smyers-payne@calfee.com